

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1 and 3-8 are currently pending in the present application, Claim 1 having been amended, and Claim 2 having been canceled without prejudice or disclaimer.

In the outstanding Office Action, Claims 1-8 were rejected under 35 U.S.C. §103(a) as unpatentable over Geiger et al. (U.S. Patent No. 6,463,534, hereinafter Geiger) in view of Salo et al. (U.S. Patent No. 6,563,800, hereinafter Salo).

With respect to the outstanding rejection, Claim 1 is amended to more clearly describe and distinctly claim the subject matter Applicants regard as the invention. Support for the amendment to Claim 1 is found in original Claim 2, and no new matter is added.

Amended Claim 1 recites, *inter alia*, “network interface unit, includes a WAP gateway configured to receive said static or dynamic WML coded data from the Web server, to transform said static or dynamic WML coded data into compiled WML contents, and to transmit the compiled WML contents to the standalone communicating mobile device.”
Geiger does not teach or suggest this element of amended Claim 1.

Geiger discloses a system in which consumers can purchase, download and install software into a wireless device (i.e. a secure wireless electronic-commerce system).¹ Fig. 1 of Geiger illustrates how a landline telephone 12 or a computer 13 can be used to input an order to the secure electronic commerce infrastructure 10 at web server 16.² The order is transmitted across network PSTN to the secure electronic commerce infrastructure 10.

Included within the electronic commerce infrastructure are servers 15-18. Servers 15 and 17 create and distribute public keys and make software available for download to the

¹ Geiger, Abstract, lines 13-16.

² Geiger, col. 2, lines 61-65.

mobile device.³ WAP proxy server 18 translates HTML syntax into WML syntax, and vice versa.⁴ Server 16 merely receives the order/communication transmitted from landline telephone 12 or computer 13.⁵

WAP proxy server 18 does not equate to the claimed “WAP gateway.” As stated in Claim 1, the “WAP gateway” is included in the “network interface unit.” Geiger does not describe that WAP proxy server 18 is included in a “network interface unit.” As amended Claim 1 further clarifies, “the network interface unit” and the “WAP gateway” are separate from the “automatism unit.”

The outstanding Office Action asserts seems to assert that secure electronic-commerce infrastructure 10 equates to the claimed “automatism unit.” Since Fig. 1 of Geiger shows that WAP proxy server 18 is included within the secure electronic-commerce infrastructure 10, it does not describe the claimed “WAP proxy server.” Furthermore, Geiger does not suggest removing WAP proxy server 18 from the secure electronic-commerce infrastructure 10.

The outstanding Office Action states that Geiger does not explicitly teach a web server that generates static or dynamic WML coded data.⁶ Thus, Geiger cannot describe or suggest “wherein said network interface unit, includes a WAP gateway configured to receive said static or dynamic WML coded data from the Web server, to transform said static or dynamic WML coded data into compiled WML contents, and to transmit the compiled WML contents to the standalone communicating mobile device.” Geiger’s description of “delivering a content item to the wireless device”⁷ does not describe or suggest the above-quoted element of amended Claim 1.

³ Geiger, col. 3, lines 9-12 and 42-51.

⁴ Geiger, col. 3, lines 48-51.

⁵ Geiger, col. 3, lines 9-12 and 42-51.

⁶ Office Action, page 3,.

⁷ Geiger, col. 9, lines 4-5.

Salo does not cure the deficiencies of Geiger. Salo only describes that active server pages (ASPs) perform dynamic rendering of web content which can be delivered to any browser and that remote access devices may use WML.⁸ Salo does not describe or suggest "wherein said network interface unit, includes a WAP gateway configured to receive said static or dynamic WML coded data from the Web server, to transform said static or dynamic WML coded data into compiled WML contents, and to transmit the compiled WML contents to the standalone communicating mobile device."

Furthermore, the outstanding Office Action provides no explanation of the motivation to select the wireless electronic commerce system of Geiger, select the data center for providing access to subscriber information of Salo, and combine them. See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and the requirement there for the PTO to "explain the reasons one of ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious."

In effect, the outstanding final rejection does little more than attempt to show that parts of the inventive combination of Claim 1 were individually known in other arts and to suggest that such a showing is all that is necessary to establish a valid case of *prima facie* obviousness. The PTO reviewing court recently reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to

⁸ Salo, col. 10, lines 21-25 and col. 7, lines 20-25.

determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added.]

There has been no such showing of those required reasons made in the final rejection.

In view of the above noted distinctions, Applicants respectfully submit that Claim 1 (and its dependent Claims 2-7) patentably distinguish over Geiger and Salo, alone or in combination.

Claim 8 is similar to Claim 1. Applicants respectfully submit that Claim 8 patentably distinguishes over Geiger for at least the reasons given for Claim 1.

In addition to the reasons stated above, Claim 7 is further patentably distinguishable over Geiger and Salo because neither of the cite references describes or suggests "wherein the Web server includes in the notification a list of addresses from an addressee directory stored in a local memory or in a remote memory on the network."

The outstanding Office Action merely states that Fig. 1 of Geiger shows a global network.⁹ Geiger provides no description or suggestion that any of the web servers shown in Fig. 1 includes in the notification a list of addresses from an addressee directory stored in a local memory or in a remote memory on the network.

Salo does not cure the above-noted deficiency in Geiger. Salo does not describe or suggest "wherein the Web server includes in the notification a list of addresses from an addressee directory stored in a local memory or in a remote memory on the network."

⁹ Office Action, page 5.

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Consequently, in view of the above amendments and comments, it is respectfully submitted that the outstanding rejection is traversed and that the pending claims are in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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